

Appl. Serial No.: 10/821,441
Amendment dated November 23, 2005
Reply to Office action of August 23, 2005

REMARKS

As noted above, the Applicants appreciate the Examiner's thorough examination of the subject application.

Claims 1-69 remain in the application, with claims 34-69 being withdrawn from consideration. Claims 1-4, 7-15, 21-23, and 30-33 were rejected in the Office Action mailed August 23, 2005. Claims 5-6, 16-20, and 24-29 were indicated as being allowed over the prior art. By this amendment, claim 1 has been amended to more clearly define the invention. The subject application supports this amendment and no new matter has been added.

As a preliminary matter, while the Office Action Summary sheet indicated that claims 1-33 were rejected in their entirety, the Applicants understand that this may have been an inadvertent indication as both the current Office Action (in item 6) and the previous Office Action indicate that claims 5-6, 16-20, and 24-29 are allowed.

Concerning item 1-2 of the Office Action, the Applicants thank the Examiner for entering the Request for Continued Examination submission and the amendment that were filed on July 13, 2005 for the subject application.

Claim Rejections Under 35 U.S.C. 103

Concerning items 3-5 of the Office Action, claims 1-4, 7-15, 21-23, and 30-33 were rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,239,445 to Shaeef ("Shaeef") in view of U.S. Patent Application Publication No. US 2002/0015667 to Chow ("Chow") and U.S. Patent No. 3,998,145 to Maisch ("Maisch"). Applicants respectfully traverse this rejection and request reconsideration and withdrawal of the rejection for the following reasons.

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For a rejection under 35 U.S.C. § 103(a), the combination of references must teach or suggest each and every limitation as arranged in the claims at issue. In this situation, the combination of Shaeef, Chow, and Maisch cited by the Examiner fails to teach or suggest each and every limitation as arranged in amended independent claim 1, from which claims 2-4, 7-15, 21-23, and 30-33 depend.

Independent claim 1 has been amended to more clearly define the claimed invention and now recites:

A tray assembly for use with an optical inspection apparatus adapted to inspect a liquid sample, the tray assembly comprising: a support tray configured for insertion within an inspection location of an optical inspection apparatus and configured so that a light source of the apparatus illuminates a liquid sample carried on the support tray and a detector of the apparatus receives light from the liquid sample when the support tray is positioned at the inspection location; and an insert configured to be supported by the support tray and having a first surface, wherein the first surface is shaped and adapted to receive and secure in place a first type of liquid carrier, and a second surface, wherein the second surface is spaced apart from the first surface and shaped and adapted to receive and secure in place a second type of liquid carrier that is shaped differently from the first type of liquid carrier, and wherein only one of the types of liquid carriers can be received and secured in place on its respective surface of the support tray at any one time while the insert is supported by the tray, wherein either one of the first and the second surfaces of the insert can be presented when the insert is supported within the support tray in order to receive one of the first and the second types of liquid carrier for optical inspection. [Emphasis added]

For the invention recited in amended claim 1, only one liquid carrier is received by and secured to the support tray at any one time, depending on which one of the first and the second surfaces of the insert is facing away from the support tray as the insert is supported within the support tray. This configuration allows one of either of the first or the second types of liquid

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carrier to hold a liquid sample for illumination by the light source of the inspection apparatus when the support tray is inserted within the inspection location within the optical inspection apparatus. This configuration also allows for reduced cost and easier, quicker implementation of optical testing of liquids held in different types of liquid carriers when compared to the prior art.

In contrast, Shaeef, which is owned by the assignee of the present application, discloses a tray assembly for use with an optical inspection apparatus. The assembly includes a support tray 20 shaped and adapted to receive one of a first liquid sample carrier 22 or an insert 40. The support tray 20 has only a single surface 30 shaped and adapted to receive either a first liquid sample carrier 22 or a second liquid sample carrier 40. The liquid sample carriers 22 and 40 of Shaeef are not shaped differently from one another, and are described only as having a single receiving surface for a reagent strip 46 or an opening or, alternatively, a well 24 for receiving a bodily fluid such as urine. See Shaeef, col. 3, lines 6-8 and 60-62.

In the Office Action of April 13, 2005, the Examiner noted that Shaeef suggests in Column 5, lines 32-37, that "modifications of the inspection apparatus 10 will be obvious to those of ordinary skill in the art. For example, instead of providing the support tray 20 with the recess 30, the support tray 20 could be adapted to be physically coupled to each of the liquid carriers 22, 40 in alternative ways." (emphasis supplied by the Examiner). Applicants respectfully contend that the only logical interpretation of the cited portion of text is that Shaeef suggests that its support tray may be adapted for coupling to a single liquid carrier (of which two kinds are taught 22, 24) by means other than by "providing the support tray 20 with recess 30." In support of this, Shaeef refers to physically coupling "each of the liquid [specimen] carriers 22, 40" without suggesting that they be of different shapes. The only other possible semantic interpretation of the cited portion of text would seem to be that the Shaeef tray is simultaneously coupled to each opposing side of the liquid carrier, a situation that is not described in Shaeef, and

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that would interfere with optical measurements of a liquid under inspection. Accordingly, one skilled in the art would understand that Shaeef does not teach or suggest the limitations of claim 1, e.g., that the liquid specimen carriers be of different shapes, and that two different liquid-carrier-receiving surfaces (of different shapes) be provided simultaneously on a single tray insert.

In contrast to the invention recited in claim 1, Chow teaches a tray assembly 10 for chemical and biological analysis systems that includes a base 12 shaped and adapted to receive an adapter (i.e., insert) 14, which in turn has a single attachment region (i.e., surface) shaped and adapted to receive a substrate (i.e., liquid specimen carrier) 16. The tray assembly 10 of Chow is similar to the tray assembly shown in Figs. 4, 5, and 6 of Shaeef, e.g., they both have a base and an adapter received in the base, wherein the adapter receives a liquid carrier on a single side only. Chow does not teach or suggest an adapter that has two different sides each having a different shape and each configured for receiving a differently shaped liquid carrier as recited in claim 1. Thus, Chow does not overcome the deficiencies of Shaeef described above.

Furthermore, Applicants respectfully take issue with and traverse the Examiner's conclusion regarding Chow that "In the case of similar apparatus designed to received two different sample carriers, it would have been obvious to one of ordinary skill in the art at the time the invention was made to employ one 'two-sided' adapter, instead of two 'one-sided' [adapters], in order to simplify sample handling and to make the process less time consuming." The logic for this conclusion is not apparent. Because of this, the Applicants respectfully submit that the Examiner may have used improper hindsight analysis for the conclusion as none of Shaeef, Chow, or Maisch (discussed below) teach or suggest the desirability of a two-sided sample tray adapted for optical analysis of bodily fluids (liquids).

Maisch also contrasts with the invention recited in claim 1 – and is considered by the

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Applicants to be non-analogous art, as explained below. Maisch discloses a food preparation appliance usable as a waffle iron or a grill. The waffle iron includes a set of removable contact members that slide over heating rods. Each of the contact members has different surface patterns on opposite surfaces, such that the contact members can be turned over to present one of the different surface patterns, e.g., one set of patterns may be used for baking waffles and the other set of patterns for grilling meat. Maisch teaches that two inserts must be used simultaneously (col. 1, lines 22-34) and that the surfaces of each respective insert have different shapes that are "adapted to different heating or cooking processes" (col. 2, lines 20-21). Maisch does not teach or suggest that the insert has first and second differently shaped surfaces that are each adapted to receive and secure a different type of liquid carrier. The surfaces of Maisch are shown as being flat or having a regular saw-tooth profile or are described as having "a waffle design such as is customary for waffle irons. See Maisch, col. 2, lines 23-24. Thus Maisch does not cure the deficiencies noted above for Chow and Shaeef.

For a rejection under 35 U.S.C. § 103(a), not only must all the claim limitations be taught or suggested by the cited references (a requirement that is not met here, as noted above), each of the cited references must additionally be analogous art. In making the instant rejection, the Examiner may have used impermissible hindsight analysis as Maisch is non-analogous art. Applicants note that this assertion concerning Maisch was previously presented in Amendment B and this assertion was not been refuted by the Examiner in the outstanding Office Action.

As noted above, Maisch teaches a food preparation appliance with two hinged parts, usable as a waffle iron and also as a meat grilling utensil. See Maisch, Abstract. In contrast, the claimed invention of the subject application is directed to tray assemblies for use with an optical inspection apparatus adapted to inspect a liquid sample. For a prior art reference to be analogous for the purposes of a rejection of a patent application under 35 U.S.C. § 103(a), the reference must meet one

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of two criteria: "the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." In *re* Otiker, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). Because Maisch is directed to food preparation appliances usable as a waffle iron and a meat grilling utensil, one of skill in the art would not appreciate Maisch as being in the field of Applicants' endeavor or as being pertinent to the problems to which the subject application is directed. Furthermore, the fact that under the Manual of Patent Classification, Maisch is classified in Class 99 for Food and Beverages: Apparatus, is another factor militating against Maisch being analogous art relative to the subject application. As such, Maisch is non-analogous art and not a proper basis for a rejection under 35 U.S.C. § 103(a).

Accordingly, the combination of Shaeef, Chow, and Maisch does not form a proper basis for a rejection of claims 1-4, 7-15, 21-23, and 30-33 under 35 U.S.C. 103(a). The rejection should therefore be withdrawn.

Conclusion

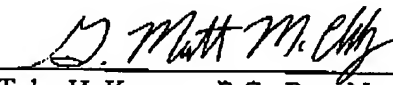
In view of the amendments and remarks submitted herein, Applicants believes that claims 1-33 pending in the application are in condition for allowance, and respectfully requests a Notice of Allowance for the application. If a telephone conference will expedite prosecution of the application the Examiner is invited to telephone the undersigned.

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If additional fees are required, or otherwise necessary to cover any deficiency in fees already paid, authorization is hereby given to charge our deposit account no. 50-1133.

Respectfully submitted,
McDermott Will & Emery LLP

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